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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/003,465

12/06/2001

Stephen J. Cutler

43257

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06/28/2006

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.

1300 19TH STREET, N.W.

SUITE 600

WASHINGTON,, DC 20036

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/003,465

Applicant(s)

CUTLER ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 27-31 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 27-31 is/are allowed.
- 6) ☐ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

I. Rejection of claims 1-26,32-35 under 35 USC 103(a) as being obvious over Giddings will not be maintained in light of amendment filed 4/7/05. Claims 1-26,32-35 are cancelled.

II. New Rejection under 35 USC 112, 1<sup>st</sup> paragraph

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1404 (CAFC, 1988)):

- 1) Nature of invention.
- 2) State of prior art.
- 3) Quantity of experimentation needed to make or use the invention based on the content of the disclosure
- 4) Level of predictability in the art.
- 5) Amount of direction and guidance provided by the inventor.
- 6) Existence of working examples.
- 7) Breadth of claims.

8) Level of ordinary skill in the art.

See below:

1) Nature of the invention.

The nature of the invention is to a method of controlling aquatic pest with a benzoquinone compound.

2) State of the prior art and the predictability or lack thereof in the art.

The state of the prior art is that it involves screening *in vitro* and *in vivo* to determine which aquatic pests would be controlled by instant benzoquinone compound. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any pesticidal regimen on its face. The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pesticide art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. Further, their mode of action is often unknown or very unpredictable and administration of the pesticides can be accompanied by undesirable side effects.

Thus, in the absence of a showing of correlation between numerous aquatic pests classes and instant benzoquinone compounds, one of ordinary skill in the art is unable to fully predict possible results from the administration of the compound in control of the numerous aquatic pests due to the unpredictability of the role of the benzoquinone compounds.

3) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The quantity of experimentation needed is undue experimentation. One of ordinary skill in the art would have to collect all classes of aquatic pests and treat each class with the benzoquinone compound to determine which of the benzoquinone compounds would be effective in aquatic pests control.

6) Existence of working examples.

Applicant provides a working example on pages 15-22 for the control of pests using benzoquinone compounds. See Table 1. However, test results do not come near to testing all aquatic pests. Claim 36 is extremely broad due to the vast number of aquatic pests.

8) Level of ordinary skill in the art.

The level of ordinary skill in the art is high. Due to the unpredictability in the pesticide art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by *in vitro* and *in vivo* screening to determine which aquatic pests are controlled by instant benzoquinone compounds. Hence, the specification fails to provide sufficient support of the all classes of aquatic pests. As a result necessitating one of ordinary skill in the art to perform an exhaustive search to determine which classes of aquatic pests would be controlled by benzoquinone compounds in order to practice the claimed invention.

*Genentec Inc. V. Novo Nordisk A/S* (CAFC) 42 USPQ 2D 1001, states that:

“a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion” and “[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable”.

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Therefore, in view of the Wands factors, and *In re Fisher* (CCPA 1970) discussed above, to practice the claimed invention herein, a person of ordinary skill in the art would have to engage in undue experimentation to test each class of aquatic pests with instant benzoquinone compounds, with no assurance of success.

III. Claims 27-31 are allowable. The prior art does not teach or suggest instant invention to control mollusk.

### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized, cursive script.

Alton Pryor  
Primary Examiner  
AU 1616